

**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventors: Lawrence Gibson et al. **Examiner:** Geoffrey Mruk
Application No: 10/825,840 **Group Art Unit:** 2853
Filing Date: April 15, 2004 **Confirmation No:** 9449
Title: FLUID EJECTION DEVICE UTILIZING A ONE-PART EPOXY
ADHESIVE

**COMMISSIONER FOR PATENTS
PO Box 1450
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RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

In response to Examiner's Office Communication dated October 13, 2006 Applicants respond as follows:

Examiner has identified two distinct inventions:

- I. Claims 1-42 drawn to a fluid ejection device, classified in class 347, subclass 45; and
- II. Claims 43-50 drawn to a method of manufacturing a fluid ejection device, classified in class 156, subclass 330.

In addition, Examiner has identified three patenably distinct species:

- Species 1, as shown in Fig. 1;
- Species 2, as shown in Fig. 2; and
- Species 3, as shown in Fig. 4.

Further, Examiner has identified 3 sub-species:

- Sub-Species A, claim 5 drawn to a thermal resistor actuator;
- Sub-Species B, claim 6, drawn to a piezoelectric actuator; and
- Sub-Species C, claim 7 drawn to an acoustic actuator.

Applicants affirm that the above two groups identified by the Examiner are patentably distinct. Applicants also affirm that the above 3 species identified by the examiner are patentably distinct as well as the sub-species. However, Applicants believe that the restriction requirement is improper and traverse this restriction requirement.

Applicants note that MPEP §806.04(f) states that where "two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. This may also be expressed by saying that to require restriction between claims limited to species the claims must not overlap in scope." Examiner appears to have simply picked figures 1, 2 and 4 without understanding the relevance of the figures to the claims. In so doing Examiner has not identified the true species associated with this invention but has identified various embodiments that read on limitations that are not mutually exclusive. MPEP 806.04(e) clearly states the "scope of a claim may be limited to a single disclosed embodiment (i.e., a single species, and thus be designated a specific species claim. Alternatively, a claim may encompass two or more of the disclosed embodiments (and thus be designated a generic or genus claim). Applicants assert that the figures do not properly represent the true species in this case. For example, the active devices 118 shown in Fig. 1 may be utilized in the embodiment shown in Fig. 4 (see numeral 418 and also may be utilized in the embodiment shown in Fig. 2 but not particularly pointed out simply because of the portion of the view Applicants elected to show. Therefore by the definition given above the figures alone cannot in this particular case be used to identify species that are mutually exclusive and cannot be used to identify which claims read on the figure and properly be specific species claims. Like wise the sub-species are also not mutually exclusive since there is nothing in the specification that says a fluid ejection device is limited to only one type of fluid ejector.

Further, Applicants note that Examiner "[i]n making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other." MPEP 806.04(h). Applicants

assume for this response that Examiner is clearly asserting that all of the identified species and sub-species described in the Office Communication are clearly patentable over each other.

Finally, Examiner has failed to provide an explanation how a 3 way restriction along with a 3 sub-species is a reasonable number of species since "the examiner may require restriction of the claims to not more than a reasonable number of species" 37 C.F.R. §1.146. Examiner has provided no reasoned explanation of why claims to species 1 and 2 or claims to species 2 and 3 cannot be examined together without causing any undue burden.

The present restriction requirement not only improperly shifts the Examiner's burden to the Applicants, but also subjects the Applicants to the added financial burden of prosecuting different claims in an unreasonable number of separate proceedings. Applicants respectfully request that Examiner reconsider the current restriction and withdraw this restriction requirement.

Thus, Applicants hereby provisionally elect with traverse Group I, Species 3 and Sub-Species A covering claims 1-5, 8-9, and 11-42. Applicants assume for purposes of this response that Examiner has made a complete requirement for restriction in accordance with MPEP §§815 and 817. If Examiner has not made a complete requirement then Applicants respectfully request that Examiner withdraw this restriction requirement and provide a complete restriction requirement so that Applicants can properly assess Examiner's assertions. Applicants believe that this reply is complete and represents a *bona fide* attempt to advance prosecution of this application. If Examiner disagrees with Applicants election Examiner is invited to contact applicants' representative to discuss how best to resolve any outstanding issues, so that prosecution on the merits for this case is not further delayed. In addition, Applicants make this election based on the understanding that Applicants are not prejudiced against filing one or more divisional, continuation, and/or continuation-in-part applications that cover the non-elected claims.

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PATENT APPLICATION

Attorney Docket No: 200308693-1
Application No. 10/825,840

The examiner has required restriction between product and process claims. Where Applicants elect claims drawn to the product, and the product claims are subsequently found allowable, withdrawn method claims that depend from or otherwise include all the limitations of the allowable product claims will be rejoined in accordance with the provisions of MPEP §821.04. Method claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Applicants further note that upon allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species.

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Respectfully submitted,
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